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REMARKS

I. Claim Amendments

Claims 1, 15, 23, 29, and 30 have been amended, as summarized below:

In claim 1, the recited "actuator" is qualified as "being separated from the brake by a distance of approximately three feet or more."

In claim 15, the inventive apparatus is qualified as "being free of wall board compound."

In claim 23, the "elongated handle" is qualified as "having a length of approximately three feet or more."

In claim 29, the remotely-applied braking force is qualified as being applied "from a location on the handle approximately three feet or more from the frame."

In claim 30, the remotely-applied cutting force is qualified as being applied "from a location on the handle approximately three feet or more from the frame."

II. Anticipation Rejections

Claims 1, 4-6, 9-12, 15, 18-20, 23-26, 29, and 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,452,663 ("Heaton"). In presenting a 102(b) rejection, it is incumbent upon the Examiner to present a *prima facie* case of anticipation. That requires that the Examiner provide a reference that teaches each and every element of the rejected claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). These rejections are respectfully traversed, because each of the claims as presented herein contain at

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least one limitation that is not disclosed by Heaton.

In claim 1, the recited "actuator" is qualified as "being separated from the brake by a distance of approximately three feet or more." Similarly, in claim 29, the remotely-applied braking force is qualified as being applied "from a location on the handle approximately three feet or more from the frame." These features of the claimed invention are commensurate with one of the advantages of the invention, namely that it be able to apply tape over a wide range of motion, e.g., without requiring the user to rely on mobility aids (*Applicant's Specification*, at page 4, lines 10-12, and page 7, last line through page 8, line 3).

Heaton fails to disclose an elongated handle or the location of an actuator at a position remote from a brake, as is presently claimed. Heaton describes a relatively compact apparatus that purportedly permits a user to apply both tape and compound to a wall board. Heaton also describes a trigger for actuating a brake, with the trigger being positioned near the brake, rather than being remote from the brake in the sense recited by claim 1 (and similarly, claim 29). There is simply no teaching in Heaton that a braking force be applied to a brake from a remote location, e.g., from a distance of approximately three feet or more. Accordingly, it is submitted that claims 1 and 29, as well as the claims that depend therefrom, are patentably distinct from Heaton.

In claim 15, the inventive apparatus is qualified as "being free of wall board compound." Heaton describes a device that combines the functions of applying tape and applying compound to wall board. The intended dual function of Heaton compromises the ability of the device to perform either function, when considered independently. For example, although Heaton claims to admit to a number of embodiments, the compound reservoir 28 of Heaton is limited to configurations that

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establish sufficient (compound) hydrostatic pressure for the compound therein to flow directly to the surface of the tape (see Heaton, col. 3, lines 18-20). This limits that ways in which the apparatus may be oriented when applying tape to a wall board seam, because certain orientations (e.g., tilted back to reach an upper portion of a seam) will result in a loss or reduction of the hydrostatic pressure required for compound to flow from the reservoir to the dispensed tape. This limitation may be contrasted with the present invention in which the tape dispensing function may be achieved in virtually any orientation of the apparatus without fear of frustrating another intended function, namely the application of compound. Accordingly, claim 15, as well as the claims that depend therefrom, are also submitted to be patentably distinct from Heaton.

III. Obviousness Rejections

Claims 1-6, 9-20 and 23-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton in view of U.S. Patent No. 6,540,856 ("O'Mara"). However, O'Mara has only been applied to claims 2, 3, 13, 14, 16, 17, 27, and 28 (*Office Action*, pages 5-9). Since Heaton has been applied exclusively in support of the obviousness rejections concerning claims 1, 4-6, 9-12, 15, 18-20, 23-26, and 29-31, the rejection of these claims is submitted to be founded under Section 102(b) rather than Section 103(a), and is therefore addressed by the remarks above (i.e., Heaton fails to teach each of the recited limitations of these claims).

Claims 1, 4-7, 9-12, 15, 18-21, 23-26, 29 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton in view of U.S. Patent No. 5,236,540 ("Shi"). However, Shi has only been applied to claims 7 and 21 (*Office Action*, pages 9-12). Since Heaton has been applied

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exclusively in support of the obviousness rejections concerning claims 1, 4-6, 9-12, 15, 18-20, 23-26, 29, and 31, the rejection of these claims is submitted to be founded under Section 102(b) rather than Section 103(a), and is therefore addressed by the remarks above (i.e., Heaton fails to teach each of the recited limitations of these claims).

Claims 1, 4-6, 8-12, 15, 18-20, 22-26, 29 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Heaton in view of U.S. Patent No. 5,792,310 ("Thompson"). However, Thompson has only been applied to claims 8 and 22 (*Office Action*, pages 12-16). Since Heaton has been applied exclusively in support of the obviousness rejections concerning claims 1, 4-6, 9-12, 15, 18-20, 23-26, 29, and 31, the rejection of these claims is submitted to be founded under Section 102(b) rather than Section 103(a), and is therefore addressed by the remarks above (i.e., Heaton fails to teach each of the recited limitations of these claims).

Each of the obviousness rejections is respectfully traversed because the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met: 1) there must be some objective suggestion or motivation, either in the prior art reference(s) or in knowledge generally available to one of ordinary skill in the art, to modify to combine reference teachings; 2) there must be a reasonable expectation of success by the resulting combination or modification; and 3) the combined or modified prior art reference(s) must teach or suggest *all the claim limitations* (emphasis added). *MPEP* § 2143.

In keeping with the third criterion, the obviousness rejections are predicated on the conclusion that Heaton discloses each of the limitations of the rejected claims, except those limitations that are met elsewhere – namely by O'Mara, Shi, and Thompson, as they have been

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respectively applied by the Examiner. The limitations of claims 1 and 29 related to actuator/brake distance, and the limitation of claim 15 related to the absence of compound, are alleged to be taught by Heaton (*Office Action*, at paragraphs numbered as 5, 6, and 7). For reasons expressed above concerning the anticipation rejection, it is submitted that Heaton fails to disclose these limitations – particularly as these limitations are qualified by the present amendment to the claims. Thus, the proffered combinations of references fail to teach all of the limitations of claims 1, 15, and 29, and there has been no identification of a teaching in the art that bridges these gaps between the references and the claimed invention. Accordingly, these claims, as well as the claims that depend therefrom (i.e., all other claims, including claims 2, 3, 7, 8, 13, 14, 16, 17, 21, 22, 27, and 28), are submitted to be patentably distinct.

Moreover, the first criterion of a *prima facie* case of obviousness is also lacking. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The prior art of record makes no suggestion to combine Heaton with the respective secondary references of O'Mara, Shi, and Thompson. The Examiner has apparently concluded, with respect to O'Mara, that the "readily apparent" "disadvantages of manually using a knife to cut the tape" is

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sufficient support for one of ordinary skill in the art to combine the teachings of Heaton and O'Mara. The Examiner has not, however, provided support for this statement, nor has she identified any such teaching in the art. Nor has there been any identification of an implicit motivation for the proffered combination. Heaton is directed to the need for a "simple," "inexpensive," and "effective" wall board taping apparatus that is practical for use by "the small contractor, hobbyist, or home owner" (Heaton, col. 1, lines 18-30). O'Mara is directed to particular difficulties in the application of drywall compound (also known as mud), rather than to drywall taping in general, and arguably presents a solution that more complicated and expensive than that sought by Heaton. Thus, there is no implicit suggestion in the art for combining O'Mara with Heaton because the two references are directed to dissimilar problems.

Shi is directed to preventing the withdrawal of tape from the applicator roller of a hand-held tape dispenser after the tape has been cut (Shi, col. 1, lines 17-22). Thompson is directed to applying tape dispensed from a hand-held dispenser to boxes. The dissimilar purposes of Shi and Thompson, compared to that of Heaton, negate any implicit (much less explicit) suggestion that Shi or Thompson be combined with Heaton.

IV. Conclusion

In conclusion, the Applicants submit that all of the pending claims are in condition for allowance. Reconsideration of the claims, withdrawal of the rejections, and passage of the present application to issuance are respectfully requested.

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In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/DOBS/0001 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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